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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/782,265
Filing Date: February 19, 2004
Appellant(s): DACOSTA, BEHRAM MARIO

Mr. John L. Rogitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 05 April 2005 appealing from the Office action
mailed 09 March 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct in that no amendments are outstanding or have been filled after the final rejection.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Appellant's reference to "an online dictionary" in the grounds of rejection to be reviewed designated as items (d) and (h) should refer to the "Encyclopedia Britannica Online article" as relied upon in the Final Rejection. Appellant's arguments properly refer to the "Encyclopedia Britannica Online article".

Appellant's reference in item (e) to claims 10, 14, and 16 having been rejected under 35 U.S.C. 103(a) over Thomsen in view of an IBM Technical Bulletin is correct in view of the grounds set forth in the Final Rejection. However, the particular grounds included typographical errors corresponding to limitations and claims which were not argued by appellant. Accordingly, the grounds in the examiner's action and corresponding grounds on appeal shall be construed as referring to claims 10 and 14-16 and the examiner's rejection set forth herein has been corrected for the Board's consideration.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,359,601	WASILEWSKI ET AL	10-1994
6,496,122	SAMSELL	12-2002
6,055,569	O'BRIEN ET AL	4-2000
5,923,379	PATTERSON	7-1999
5,543,851	CHANG	8-1996
6,097,441	ALLPORT	8-2000

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5,809,471	BRODSKY	9-1998
5,671,019	ISOE ET AL	9-1997
2002/0067428	THOMSEN	6-2002

"Expanding the capabilities of closed caption", IBM technical Disclosure Bulletin, Issue 452 (December 2001), p. 2129.

"Encyclopedia Britannica | Premium Service", [online] [retrieved on 2005-04-06]

Retrieved from the Internet Archive (WayBack Machine) using Internet <URL:

<http://web.archive.org/web/20030201101838/http://www.britannica.com/premium/>>

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 2, 5, 6, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al. (US Pat No. 5,359,601), in view of Isoe et al. (US Pat No. 5,671,019), and in further view of Brodsky (US Pat No. 5,809,471).

In consideration of claim 1, the Wasilewski et al. reference discloses a method comprising television receiving equipment and a remote controller wherein a user is operable to "receive from a head end transmitter" [68] "along with the program, closed captioning text" which may subsequently be displayed (Figure 4; Col 4, Lines 42-62; Col 5, Lines 60-63; Col 6, Lines 6-23 and 54-59; Col 8, Lines 25-28). The reference, however, is silent with respect to the particular further usage of PIP windows in conjunction with the display device. In an analogous art pertaining to television systems, Figures 1 and 2 of Isoe et al. disclose a conventional television system that further

comprises a remote control device [6] which is operable to “display with the program closed captioning text” and a PIP window (Col 1, Lines 31 – Col 3, Line 6).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the television receiver [76/78] of Wasilewski et al. so as to further support PIP functionality in connection with the display of closed captioning retrieved from the headend and a program for the purpose of providing flexibility in allowing a viewer to individually watch a full-screen image or any partial-screen image of their preference (Isoe et al.: Col 1, Lines 50-53). Taken in combination, the references disclose a television receiver that is operable to receive/process/display closed captioning as derived from a headend transmission along with a received program corresponding to that program as well as a PIP window.

The combined references, however, do not particularly disclose the ability to retrieve supplemental content related to the television program. In an analogous art pertaining to television systems, the Brodsky reference illustrates a system [100] for implementing a “method for obtaining information based on a TV program”. The method “permits a user of a remote control device” (voice actuated or otherwise) to “select at least one word to establish a selected word” through a user interface [110] wherein “if the selected word is a primary word, [the system] displays a list of content related to the selected word” (Brodsky: Col 5, Lines 11-35; Col 6, Lines 12-42). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the combined television receiver of Wasilewski et al. and Isoe et al. with the teachings of Brodsky for the purpose of providing a user watching and/or listening to a

program to retrieve supplemental information pertaining to an item just seen or words just heard (Brodsky: Col 1, Lines 51-54).

Taken in combination, the references provide a “method for obtaining information based on a TV program”. In particular, while a viewer of the combined Wasilewski et al. and Isoe et al. receiver is watching a headend transmitted/distributed video program with its associated closed captioning on, the system subsequently receives a command as taught by Brodsky so as to present a list of valid requests within a PIP window pertaining to available choices for which supplemental content may be retrieved. Accordingly, turning to Figure 2 of Isoe et al., the system “displays with the program” (ex. program A), “closed caption text” comprising the combination of that designated as “caption for ‘A’ as well as the listing of valid terms from the closed captioning as populated in the PIP window ‘B’ in response to the user’s request for the display of valid choices. Subsequently, “primary words as received from the headend transmitter” or words associated with a listing of available topics (Brodsky: Col 4, Lines 44-47) “appear differently within the closed captioning text “ associated with the entire display “than remaining secondary words” by virtue of their further appearance within the list of selectable keywords “when the closed captioning text is presented on a display of a TV prior to any user selection of words in the closed captioning text” (Brodsky: Col 5, Lines 26-35). Alternatively, “primary words within the closed captioning text . . . appear differently within the closed captioning text than remaining secondary words when the closed captioning text is presented on a display of a TV prior to any user selection of the words in the closed captioning text” simply by virtue of primary words and secondary

words being different words from one another (ex. the word “France” appears differently than the word “in”). The user can subsequently utilize the aforementioned “remote control device” such as that associated with any of the combined references, to select a word from the list of valid choices for subsequent display of associated content as taught by Brodsky.

In consideration of claim 2, Brodsky discloses that the “list is displayed in a picture-in-picture (PIP) window on the TV” (Brodsky: Col 5, Lines 22-35).

Claim 5 is rejected wherein the Brodsky reference discloses that the system “permits a user to select at least one content on the list and displaying the content” (Brodsky: Col 6, Lines 12-42).

Claim 6 is rejected wherein the Brodsky reference discloses that the “content is obtained from an audio/video data storage” such as a local or remote CD-ROM “associated with the TV” (Brodsky: Col 6, Lines 12-42).

With respect to claim 8, the Brodsky reference discloses that a “processor” [106] “associated with the TV” [108] is operable to “add the content to a local data storage associated with the TV and correlate the content with other content related to the selected word” associated with the pre-fetched content associated with a particular keyword (Brodsky: Col 5, Line 64 - Col 6, Line 11).

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al. (US Pat No. 5,359,601), in view of Isoe et al. (US Pat No. 5,671,019), in view of Brodsky (US Pat No. 5,809,471), and in further view of Sampsell (US Pat No. 6,496,122).

In consideration of claim 3, the combined references do not disclose that the particular “list is displayed on a display of the remote control device”. In an analogous art pertaining to television systems, the Sampsell reference discloses a “remote control device” [170] that provides picture-in-picture (PIP) functionality and the ability to display/control menus (Sampsell: Col 4, Lines 17-28; Col 10, Line 5 – Col 11, Line 25). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the remote controller of the aforementioned combined references such that the “list is displayed on a display of the remote control device” for the purpose of providing a means by which the user can provide for the viewing of multiple image display devices and associated menus without covering upon part of an image displayed on an image screen as in convention picture-in-picture (PIP) technology (Sampsell: Col 2, Lines 54-58).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al. (US Pat No. 5,359,601), in view of Isoe et al. (US Pat No. 5,671,019), in view of Brodsky (US Pat No. 5,809,471), and in further view of Chang (US Pat No. 5,543,851).

With respect to claim 4, as aforementioned, the Brodsky reference does not particularly disclose nor preclude that the supplemental information may not include the ability for the “user [to] select a word to cause the computer to transmit to the TV a dictionary definition of the word”. The Chang reference provides evidence that it is known for a “user [to] select a word to cause the computer to transmit to the TV a dictionary definition of the word” (Chang: Col 5, Lines 33-43). Accordingly, it would have been obvious to one having ordinary skill in the art so as to modify combined

teachings so as to further provide supplemental information including a dictionary definition of a word for the purpose of providing a time efficient means for proving the user with the meaning of a term which appears in the closed caption text (Chang: Col 1, Lines 18-28).

4. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wasilewski et al. (US Pat No. 5,359,601), in view of Isoe et al. (US Pat No. 5,671,019), in view of Brodsky (US Pat No. 5,809,471), and in further view of the Encyclopedia Britannica Online article.

In consideration of claim 7, as aforementioned, the Brodsky reference discloses that the supplemental information from remotely based databases that include encyclopedias may be “downloaded” from broadcasters or dial-up service providers “in response to the user selecting the content” (Brodsky: Col 6, Lines 12-42). However, the reference does not explicitly disclose that the supplemental information may be “downloaded from at least one of: the Internet, and a transmitter head end”. The “Encyclopedia Britannica Online” article provides evidence as to the existence of Internet based encyclopedias. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to “download from at least one of: the Internet . . .” encyclopedia information such as provided by “Encyclopedia Britannica Online” for the purpose of utilizing the most complete compendium of general knowledge on the Internet as a source of supplemental data.

Claim 9 is rejected wherein the article provides evidence that it is known to “bill the user for downloading content” in connection with a subscription fee to access the online encyclopedia.

5. Claims 10 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomsen (US Pub No. 2002/00067428 A1) in view of the IBM technical disclosure bulletin (hereafter IBM-TDB).

In consideration of claim 10, Figure 1 of Thomsen illustrates a “system for obtaining information using a TV closed caption display”. As illustrated in Figure 1, the system comprises a “TV receiving content [including closed caption text] from a source” (Para. [0024]), a “remote control device configured for wireless communication with the TV” [140] (Para. [0028]), and a “data structure” (Para. [0048] and [0049]) accessible to a “computer associated with . . . the TV” [116]. The “computer” [116] “retrieves from the data structure a list of content related to at least one word appearing in the closed caption text and selected by a user manipulating the remote control device [wherein] the word appears within the closed caption text and [is] selected from the closed caption text by means of the remote control device” (Figures 3, 5, and 9-10; Para. [0024] - [0031], [0043] - [0051], [0054] - [0056]). The reference, however, is silent with respect to “the word being made to flash within the closed caption text”.

In an analogous art pertaining to television systems, the IBM-TDB reference discloses a system that provides enhancements to closed caption capabilities on most televisions such that the “word [is] made to flash within the closed caption text” (Para. 7) in accordance with a speaker’s detected emotion. Accordingly, it would have been

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obvious to one having ordinary skill in the art at the time the invention was made so as to modify the television system of Thomsen in view of the IBM-TDB for the purpose of advantageously providing enhancements to the closed caption capabilities to television receivers such that the user can determine intensity or emotion associated with the speaker.

Claim 14 is rejected wherein the “remote control device” [140] “can be manipulated to select at least one content on the list for displaying the content” (Para. [0056]).

Claim 15 is rejected wherein the “content is obtained from and audio/video data storage associated with a TV” (Para. [0049]) and the “computer is in the TV” (Para. [0024]).

Claim 16 is rejected wherein the “content is downloaded from at least one of the Internet . . . in response to the user selecting the content” (Para. [0056]).

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomsen (US Pub No. 2002/00067428 A1), in view of the IBM-TDB, and in further view of Patterson (US Pat No. 5,923,379).

In consideration of claim 11, the Thomsen reference does not disclose that the “list” (Figure 10) as presented via an Internet browser is necessarily “displayed in a picture-in-picture (PIP) window on the TV”. In an analogous art pertaining to television systems, the Patterson reference discloses “displaying in a picture-in-picture (PIP) window on the TV” information associated with a web-browser (Patterson: Col 3, Line 37 – Col 4, Line 2). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Thomsen with the teachings of Patterson so

as to “display” the “list . . . picture-in-picture (PIP) window on the TV” for the purpose of providing a means by which a user is capable for browsing the Web at the same time as another video signal is being viewed on the television (Patterson: Col 2, Lines 11-20).

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomsen (US Pub No. 2002/00067428 A1), in view of the IBM-TDB, and in further view of Allport (US Pat No. 6,097,441).

In consideration of claim 12, the Thomsen reference does not disclose that the “list” (Figure 10) as presented via an Internet browser is necessarily “displayed on a display of a remote control device”. In an analogous art pertaining to television systems, the Allport reference discloses providing Internet browser content such that it is “displayed on a display of a remote control device” (Allport: Col 6, Lines 49-64; Col 7, Lines 36-58). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Thomsen such that the “list is displayed on a display of the remote control device” for the purpose of providing a secondary user interface associated with a remote controller which leaves the primary viewing screen or TV uncluttered (Allport: Col 4, Lines 53-60).

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomsen (US Pub No. 2002/00067428 A1), in view of the IBM-TDB, and in further view of the Encyclopedia Britannica Online article.

In consideration of claim 13, the Thomsen reference suggests that the particularly selected search terms can be sent to a data warehouse so as to retrieve information that is related to the transmitted data wherein the data warehouse includes external database

such as those associated with commercial institutions (Para. [0049]). It is unclear, however, if the returned information further comprises “causing the computer to transmit to the TV a dictionary definition of the word”. In an analogous art pertaining to information distribution systems, the Encyclopedia Britannica article discloses providing or displaying “a dictionary definition of the word” (ex. Pop-up Dictionary) related to a search. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to utilize the online database as disclosed in the Encyclopedia Britannica Online article so as to facilitate the retrieval of related information including dictionary definitions for the purpose of taking advantage of the most complete compendium of generable knowledge on the Web so as to retrieve additional information regarding selected information.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomsen (US Pub No. 2002/00067428 A1), in view of the IBM-TDB, and in further view O’Brien et al. (US Pat No. 6,055,569).

In consideration of claim 17, the Thomsen reference discloses that the system is operable to utilize Internet browser techniques so as to particularly retrieve and facilitate the retrieval and display of “contents” (Para. [0057]). The reference, however, is silent with respect to a “processor associated with the TV adding the content to a local data storage associated with the TV and correlates the content with other content related to the selected word”. In an analogous art pertaining to the retrieval of information from the Internet, the O’Brien et al. reference discloses a method such that a “processor . . . adds the content to a local data storage . . . and correlates the content with other content

related” to the particular web page (Col 3, Line 28 – Col 4, Line 29). For example, if a user downloads content associated with a particular web page (ex. www.epa.gov), the system adds that web-page and correlates the web page with other related web-pages related to or associated with the selected word (ex. other pages related to www.epa.gov). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify Thomsen such that a “processor associated with the TV adds the content to a local data storage associated with the TV and correlates the content with other content related to the selected word” for the purpose of advantageously accelerating the users ability to retrieve information from the Internet in a manner which further takes advantage of the user’s probability in visiting those pages (O’Brien et al.: Col 1, Line 31 – Col 2, Line 16).

(10) Response to Argument

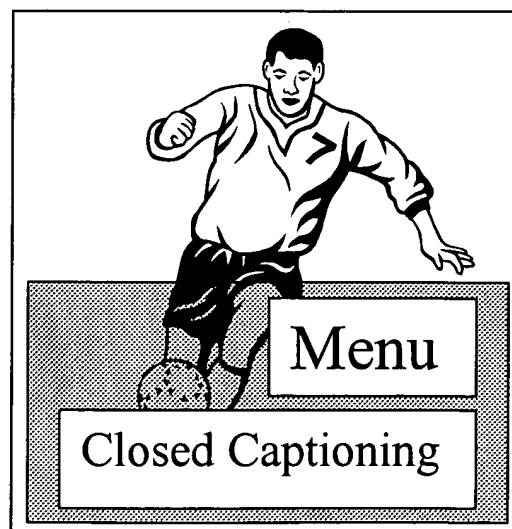
Upon consideration of appellant’s arguments the examiner respectfully disagrees that the rejection should be overturned. In summary, appellant’s arguments appear to be based upon particular claim limitations not being met by the rejection as well as the particular usage of improper hindsight reconstruction. Only those arguments raised by the appellant pursuant to the issues on appeal and directed towards the interpretation of particular claim limitations have been considered and addressed by the examiner. Any further arguments, that the appellant could have made concerning other claim limitations and/or other rational for a prima facie case of obviousness having not been made (ex. teaching away, long standing need, etc.) are considered as having been conceded by the

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appellant for the basis of this appeal and are not being subsequently addressed by the examiner for the Board's consideration.

(a) – Rejection using the combination of Wasilewski et al., Isoe et al. and Brodsky

As set forth in the rejection and concurred by appellants, the Wasilewski et al. reference teaches a headend that combined closed captioning (CC) with TV signals and Isoe et al. teaches displaying CC with TV programming as well as PIP technology. The rejection of claim 1 subsequently combines these teachings with the Brodsky et al. reference which teaches the particular display of a selectable menu of words derived from the closed captioning text in a PIP window as a selectable list from which the user may subsequently retrieve supplemental content (Brodsky: Col 4, Lines 18-47; Col 5, Lines 11-20). Taken in combination, it is the examiner's opinion that the references would suggest the following illustrative display wherein the closed captioning as derived from the headend of Wasilweski et al. is processed and displayed by Isoe et al. in a lower region of the screen, and the PIP of Isoe et al. is utilized by Brodsky et al. so as to display a list of valid selections:



Whether or not the references are properly combinable is not the question at hand; rather appellant's argue that Brodsky does not teach that the user is operable to select words from the closed captioning itself and the particular meaning of "appearing differently".

Regarding appellant's argument that Brodsky does not teach that the user is operable to select words from the closed captioning itself, the examiner respectfully disagrees. In particular appellants argue that the words are added to a dictionary as derived from the television content and that a user can later speak words or select them from a menu in order to select them. As argued, the words therefore are not selected by a user but rather are selected by a machine for addition to the dictionary and there is subsequently is no suggestion to allow a user to select a word from the closed captioning itself in order to access additional content related to the word. The examiner respectfully disagrees. The reference teaches that the words which comprise the dictionary are derived from the closed captioning text and that user can request additional content pertaining to topic recently seen or heard by selecting a word from the menu of entries (Col 2, Lines 20-23; Col 5, Lines 27-47). Irrespective of the usage of a 'machine' selection of which words are to comprise the dictionary, the user must still actively select a word for which additional information is desired in order retrieve/display a list of content. In the illustrative example provided by Brodsky, subsequent to a newscaster mentioning the word 'France', a user can display a menu to recently mentioned topics, directly select the word 'France' from a menu and subsequently display retrieved information relating to 'France' (Col 6, Lines 12-42). Accordingly, given that the particular displayed listing of valid entries within the storage buffer [104] are words from the closed captioning itself,

the particular selection of one of these words from the menu of topics serves as selecting a word from within the closed captioning itself. In the illustrated example, the user did not select 'Spain' because 'Spain' was not mentioned by the newscaster and therefore was not in the closed captioning text.

With respect to appellant's arguments regarding the interpretation of 'primary words' and 'secondary words' and what is meant by their 'appearing differently' the examiner respectfully disagrees. Appellant's initially argue that appearing differently cannot be broadly construed because of differences in spelling and subsequently argue that an illustration provided in the Final Rejection cannot be relied upon for the basis of a rejection. The examiner recognizes that claims are interpreted in light of the specification and that limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In particular, the examiner relied upon the appellants disclosure for the meets and bounds for the meaning of "appearing differently" in rejecting the claim using the previous illustration. The appellant concurs that there is no special/explicit definition of what is meant by 'appearing differently' and the specification clearly provides what is designated as a non-limiting example of the nature of appearing differently. Absent particular language to the contrary the plain and ordinary meaning of the term 'appearing differently' would seem apt.

Taking what was viewed as the broadest reasonable interpretation, it was the examiner's secondary position that primary words and secondary words could be broadly construed as appearing differently within the closed captioning, in light of the

specification, simply by virtue of the words being different from one another (ex. the word “France” appears differently than the word “in”). Appellants initially argue, however, that simply because some words are spelled differently and would subsequently be caused to appear differently as a result of this fact than other words spelled differently – these words are not to be construed as appearing differently but rather words are to be construed as appearing differently by virtue of the peculiar way the words are displayed. Appellant’s own argument appears self defeating in that appellants on one hand are conceding that some words do in fact appear differently based upon their being spelled differently, but do not appear differently in view of the claimed ‘appearing differently’ when viewed in light of a non-limited meaning of the term. Isn’t the differing appearance of the word ‘cat’ and ‘dog’ a peculiar way in which the words are displayed? Taking appellant’s example of ‘cat’ versus ‘dog’, assuming these were the only words on the display and there was only related content for the word ‘cat’, then certainly the particular word ‘cat’ is caused to appear different on the display or else the two words would appear the same. The specification further sets forth that a ‘primary word’ is different from a ‘secondary word’ by virtue of it having associated related content not simply because it “appears differently”. Why couldn’t the invention simply work such that the words were simply spelled differently and content existed for some words but not others, thereby making those words with content ‘primary words’ and those without ‘secondary words’? Even appellant’s originally filled Figure 1 simply illustrated the words “Closed Captioning” without further differentiation that supplemental content existed for one word but not the other. Appellants counter that if spelling was the sole criteria for

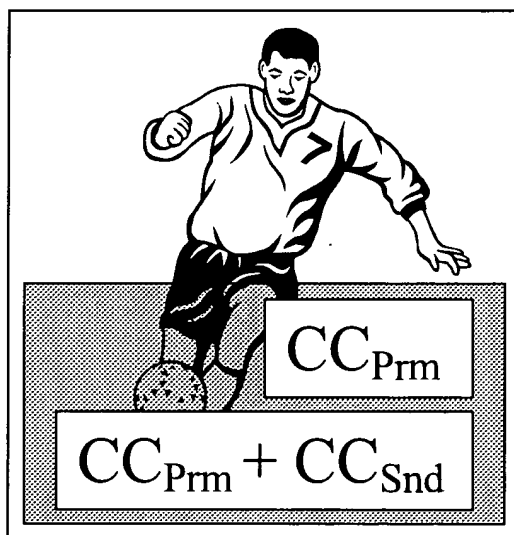
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appearing differently that every word would subsequently be a “primary word” because every word appears differently than every other word; however (putting aside the fact that the limited memory Brodsky system would need to have lists of content for every word encountered) using that line of reasoning assuming that both ‘cat’ and ‘dog’ were underlined wouldn’t they still appear differently from each other? Arguably, there might be content for ‘cat’ but not ‘dog’. If only ‘cat’ was underlined, doesn’t it still appear differently than the word ‘dog’ even though one word is underlined – not simply because one word is underlined, but also because it is also a different word? Brodsky differentiates between keywords and non-keywords (Col 3, Lines 60-62). If the words spoken were “The dog chased a cat”, then the keywords ‘dog’, ‘cat’, and ‘chased’ certainly look different than the non-keywords ‘The’, and ‘a’. Brodsky only provides a list of content for keywords or primary words which by their very nature appear different.

With respect to appellant’s second argument regarding the primary thrust of the rejection such that the words appear differently not simply because they are spelled differently, appellant’s argument appears to be simply that the rejection and its associated illustration come from the examiner’s imagination and therefore is not prior art and cannot be used as a basis for rejection. No arguments are provided such that it doesn’t illustrate or meet what is claimed or that the references are not properly combinable, simply that the provided illustration is not explicitly illustrated in the provided references. In view of what the examiner felt was confusion on the part of appellants as to how the claim was being rejected by the examiner, the Final Rejection provided an illustration of what, in the examiner’s opinion, the references in combination would have

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taught/suggested to one skilled in the art in order to better explain his position. It was/is the examiner's understanding that such is not impermissible so long as it is based upon the teachings of the references. Given that a stated goal of patent examination is to clearly articulate the basis for a rejection, why should it be viewed as improper for the examiner to provide an illustration of what is believed to be taught by combined references in rejecting a claim that is visual in nature? As such the illustration did not simply spring purely from the examiner's imagination as alleged, but was what in the examiner's interpretation one skilled in the art would have concluded was taught by the combined teachings of the references.



CC_{prm} corresponded to the primary words (or keywords from Brodsky) within both the PIP window and the caption display area of Isoe et al. CC_{snd} corresponded to the secondary words or non-keywords. Both regions within the 'grayed area' are closed captioning text. Therefore, the region itself was construed as closed captioning text and primary words within the closed captioning text (or region represented thereof) were

construed as appearing differently, not simply because the words are different themselves, but by virtue of their further/additional appearance within the PIP window of Isoe et al. The closed caption data was provided by the headend of Wasilewski et al. Accordingly, the particular further appearance of keywords within the construed closed captioning text region/area so as to highlight those words as valid choices for receiving additional content was construed as a particular way in which primary words are differentiated so as to ‘appear differently’.

In conclusion, the specification is not limiting with respect to the meaning of “appearing differently” and appellants have chosen not to limit the claimed ‘appearing differently’ to any of the exemplary disclosed methods such as making some words italicized, or bolded, or having a different font or font size or color, or to flash on and off or between bright and low. Rather, appellants have attempted to narrow the meaning of a term which by their own admission is to be provided no special meaning and is explicitly stated as being non-limiting in the specification. If appellant’s meant for “appearing differently” to be limited to a particular/specific meaning, then they should have claimed it appropriately. Accordingly, the examiner’s position with respect to claim 1 is respectfully requested to be upheld.

With respect to appellant’s arguments with respect to the further patentability of claim 2, the examiner respectfully disagrees. The claim is directed towards the particular display of the list in a picture-in-picture window. Brodsky teaches the particular display of a list of related content (ex. topical entries associated with the selected word ‘France’)

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which may be displayed in a picture-in-picture window (Col 6, Lines 31-40).

Accordingly, the examiner respectfully disagrees with the appellant's position.

With respect to appellant's arguments with respect to the further patentability of claim 5, the examiner respectfully disagrees. The claim is directed towards selecting at least one content on the list and displaying the content. Brodsky teaches the particular display of a list of related content from which the user may subsequently select for display which may be displayed (Col 6, Lines 31-40). If the user was not able to select the particular content for display, it is unclear as to how the user would obtain more informative information for display in view of the teachings of the Brodsky reference.

No further arguments have been provided with respect to claims 6 and 8.

(b) – Rejection using the combination of Wasilewski et al., Isoe et al., Brodsky, and Sampsell

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, as aforementioned, Brodsky provides evidence that the particular display of a "list of content" in a picture-in-picture (PIP) window was knowledge which was within the level

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of ordinary skill in the art at the time the invention was made. As acknowledged in the rejection, Brodsky does not teach a remote controller with an incorporated display.

Brodsky does not provide any teachings to dissuade one from using a remote controller with a display. Sampsell, as set forth in the rejection, provides evidence that a remote controller that serves as a picture-in-picture display was knowledge which was within the level of ordinary skill in the art at the time the invention was made. As noted by appellants, Sampsell teaches displaying TV images on a remote control device. Given that Brodsky is generating TV images (which would include the content list displayed on the television) and Sampsell teaches not only the particular display of TV images but the desirability to display TV images on a remote controller display, the particular reconstruction is considered proper as it does not include knowledge gleaned only from the appellant's disclosure.

(c) – Rejection using the combination of Wasilewski et al., Isoe et al., Brodsky, and Chang

With respect to appellant's argument regarding claim 4, the claim requires displaying a dictionary definition of a selected secondary word. As noted by appellants, Chang provided dictionary definitions of any word the user might happen to select. In light of the specification, words are either 'primary' or 'secondary'. If Chang provides definitions for all of the words, then it follows that the particular selection of a 'secondary word' would result in the display of a dictionary definition; thereby meeting the claim limitation. The claim doesn't preclude providing definitions for 'primary' words as well.

(d) – Rejection using the combination of Wasilewski et al., Isoe et al., Brodsky, and the Encyclopedia Britannica article

In response to appellant's argument against claims 7 and 9 such that there is no suggestion to combine the references with the Encyclopedia Britannica article, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Brodsky explicitly discloses the particular usage of local or remote encyclopedias (Col 6, Lines 29-31), but is silent with respect to nature of information being retrieved from the encyclopedia. The Britannica article clearly provides evidence as to the existence and the particular usage of online or Internet based data warehouses or encyclopedias so as to provide users with a compendium of general knowledge. The reference further provides several explicit statements (Awards & Accolades) with respect to why one would be motivated to use the particular encyclopedia/data warehouse associated with Encyclopedia Britannica® online. For example, why wouldn't one be motivated to utilize the "Net's finest encyclopedia hands down" or "The most complete compendium of general knowledge on the Web" or an encyclopedia that "... can't be beat for researching famous (and not-so famous people), places, and things" when looking for a remote encyclopedia to utilize with Brodsky.

Accordingly, it is the examiner's opinion that one would have been sufficiently motivated to particularly use an existing online encyclopedia such as that evidenced in the article in combination with the Brodsky reference.

(e) – Rejection using the combination of Thomsen, and the IBM Technical Disclosure

In response to appellant's argument that the references fail to show certain features of appellant's invention of claim, it is noted that the features upon which appellant relies (i.e., allowing the headend provider to direct attention to provider-selected primary words) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim is entirely silent with respect to any related to the usage of 'primary words'. The claim merely requires that at least one word from the closed caption text is made to flash within the closed caption text and that words can be selected. As argued by appellants, the combination of references teach that words from the closed caption text indicative of a speaker's emotion would flash which could subsequently be selected in light of the teachings of Thomsen. It does not seem unreasonable that a breaking news story about aliens invading, as illustrated in Thomsen, would involve a certain level of emotional response on the part of the speaker thereby causing flashing words. The particular flashing is argued to be independent of the word being coupled to the existence of supplemental content. The claims require nothing of the sort. Rather, the claim only requires that some words flash that that words can be selected. Accordingly, appellant's

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own interpretation of the combined teachings in light of what is actually claimed clearly renders the claim unpatentable. The rejection is respectfully requested to be sustained.

No further arguments have been provided with respect to claims 14-16.

(f) – Rejection using the combination of Thomsen, the IBM Technical Disclosure, and Patterson

With respect to appellant's arguments regarding claim 11, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As set forth in *The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000* (as retrieved via www.dictionary.com) a list is defined as 'A series of names, words, or other items written, printed, or imagined one after the other'. Figure 10 of Thomsen illustrates a web-page that clearly contains a list of content or accessible results from the illustrative search in light the common usage definition of the term. The reference is silent with respect to the particular display of such in a PIP, nor does it dissuade one from using such to display the web-page. Patterson teaches the presentation of a web page in a PIP and the desirability to allow a user to do so as noted in the rejection. Accordingly, taken in combination, the references provide for the display of the Thomsen web-page or "list" in the PIP of Patterson, thereby meeting the claim rejection.

(g) – Rejection using the combination of Thomsen, the IBM Technical Disclosure, and Allport

With respect to appellant's arguments regarding claim 12, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As aforementioned, Figure 10 of Thomsen illustrates a web-page that clearly contains a list of content or accessible results from the illustrative search. The reference is silent with respect to the particular display of such on the remote control. Allport teaches the presentation of a web page on a remote control and the desirability to allow a user to do so as noted in the rejection. Accordingly, taken in combination, the references provide for the display of the Thomsen web-page or "list" on the remote control of Allport, thereby meeting the claim rejection.

(h) – Rejection using the combination of Thomsen, the IBM Technical Disclosure, and the Encyclopedia Britannica article

In response to appellant's argument against claim 13 such that that there is no suggestion to combine the references with the Encyclopedia Britannica article, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*,

837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Thomsen suggests that the particularly selected search terms can be sent to a data warehouse so as to retrieve information that is related to the transmitted data wherein the data warehouse includes external databases such as those associated with commercial institutions (Para. [0049]). The Britannica article clearly provides evidence as to the existence and the particular usage of online or Internet based data warehouses or encyclopedias so as to provide users with a compendium of general knowledge. The reference further provides several explicit statements (Awards & Accolades) with respect to why one would be motivated to use the particular encyclopedia/data warehouse associated with Encyclopedia Britannica® online. For example, why wouldn't one be motivated to utilize the "Net's finest encyclopedia hands down" or "The most complete compendium of general knowledge on the Web" or an encyclopedia that "... can't be beat for researching famous (and not-so famous people), places, and things" when looking for a remote encyclopedia/warehouse to utilize with Thomsen. Accordingly, it is the examiner's opinion that one would have been sufficiently motivated to particularly use an existing online encyclopedia such as that evidenced in the article in combination with the Thomsen reference.

(j) – Rejection using the combination of Thomsen, the IBM Technical Disclosure, and O'Brien et al.

With respect to claim 17, the examiner is unclear as to appellant's argument given that it simply appears to merely recite what the claim recites. The specification provides

no further description as to the claimed subject matter other than to recite the language of the claim (Page 2, Para. 2) as part of the summary of the invention. As later set forth in the specification (Page 7, Para. 1), the examiner presumed that the subject matter was directed towards the caching of content. Thomsen is directed towards locating and retrieving supplemental content related to a selected word. As illustrated, this supplemental content is in the form of web-pages. O'Brien et al. teaches predictive web-page storage and retrieval involving spidering wherein the system predicts which pages the user is going to subsequently visit. O'Brien et al. subsequently caches or "adds the content" in association with a given web page to "a local data storage" or cache and further "correlates" or brings together "the content" or web-page with "other content" or web-pages "related to the selected word" in order to advantageously speed retrieval of pages. Taken in combination, the references are believed to meet the claim limitations. For example, in association with the retrieval of the list of results as illustrated in Figure 10 of Thomsen, the teachings of O'Brien would subsequently cause the system to "add the content" or associated search result web-pages to local content as well as any "other content" associated with sub-pages associated with the illustrated main page. When accessing "the content" or EPA web page, the system would further add any other content or associated web-pages related to that page in conjunction with the spidering process.

(11) Related Proceeding(s) Appendix

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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Scott Beliveau

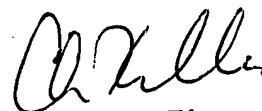
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